

REMARKS

The present application includes pending claims 1-12, 14-26, 28-32, and 34-38, all of which have been rejected. Claim 34 has been amended.

Claim 34 stands rejected under 35 U.S.C. 112, second paragraph. This claim has been amended to render this rejection moot.

Claims 1-6, 9-12, 14-17, 21-26, 28-32, 34, 37, and 38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,601,237 (“Ten Kate”) in view of U.S. 2002/0054752 (“Wood”) and U.S. 2002/0166127 (“Hamano”). Claims 7, 8, 18-20, 35, and 36 stand rejected under 35 U.S.C 103(a) as being unpatentable over Ten Kate in view of Wood, Hamano and U.S. 2004/0261096 (“Matz”). The Applicants respectfully traverse these rejections for at least the reasons previously discussed during prosecution and the following.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” *See* MPEP at 2143.03 (emphasis added). Further, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA).” *See id.* (emphasis added).

Claim 1 recites, in part, “storage at the first location for storing all idle state media and all user scheduled media; a user interface for identifying particular media as one of the idle state media or the user scheduled media [stored at the first location], wherein the user scheduled media comprises selected media content stored at the first location, wherein the user interface is used to schedule the selected media content stored at the first location according to broadcast times, and wherein the user interface is used to choose when the idle state media is

displayed; set top box circuitry at the first location communicatively coupled to the storage at the first location to support consumption of the idle state media and the user scheduled media by the television display according to selected and scheduled times.”

Claim 10 recites, in part, “selecting particular user stored media as one of idle state media or user scheduled media based upon input from a user at a first location, wherein the user scheduled media includes selected stored media arranged according to time;...”

Claim 21 recites, in part, “selecting the media **stored at the first location** as idle state media or user scheduled media based upon input from a user, wherein the user scheduled media is scheduled based on broadcasting time;...”

Claim 29 recites, in part, “wherein **all of the idle state media and the user scheduled media is stored in the storage at the first location**, wherein all of the idle state media and the user scheduled media are scheduled based on time.”

The Office Action states the following:

Ten Kate clearly teaches a method of operating a system supporting user captured media display sequencing, the method comprising:

selecting particular user stored media as one of idle state media or user scheduled media based upon input from a user at a first location; **(A user selects programs to create a virtual channel, column 4 line 64 to column 5 line 3. The user selects default media to fill the gaps in the virtual channel schedule, column 5 line 66 to column 6 line 8)**

See November 9, 2009 Office Action at pages 5-6 (emphasis in original). The Office Action relies on similar reasoning for independent claims 1 and 21.

Notably, the Office Action relies on **Ten Kate** as allegedly disclosing these limitations, as clearly shown above. However, the Applicants respectfully submit that the Office Action’s

reliance on Ten Kate as disclosing these limitations is misplaced, as explained below. Accordingly, a *prima facie* case of obviousness with respect to the pending claims has not been established.

In Ten Kate, the “virtual channel means are adapted to control the tuner to tune to a channel currently broadcasting a selected program. When a user selects the virtual channel, the apparatus takes care of automatically switching between the genuine channels broadcasting the programs viewed on the virtual channel.” *See* Ten Kate at Abstract.

Thus, Ten Kate discloses a system in which a user identifies particular programs for a virtual channel. However, **these programs are shown on genuine channels, but are not stored entirely at the user's location.** Moreover, **the user does not schedule the times of these programs.** Instead, the times are dictated by the “genuine channels.” The “apparatus takes care of automatically switching between the genuine channels broadcasting the programs viewed on the virtual channel.” *See id.* Thus, in Ten Kate, the user does not schedule any stored media according to a time schedule.

Ten Kate also discloses that “scheduling means are further adapted to record the second program, and reschedule it for the virtual channel to fill a gap before or after the programs scheduled for the virtual channel.” *See id.* at column 2, lines 36-40. Thus, in Ten Kate, the times for the virtual channel are essentially dictated by those set by the genuine channels. Portions of a second program may merely be recorded to fill in the gaps between times of programs broadcast by the genuine channels.

The Applicants respectfully submit that, **contrary to the express reasoning in the Office Action,** Ten Kate does not describe, teach, or suggest “storage **at the first location** for

storing all idle state media and all user scheduled media; a user interface for identifying particular media as **one of the idle state media or the user scheduled media [stored at the first location],**” as recited in claim 1, “selecting particular user stored media as one of idle state media or user scheduled media based upon input from a user at a first location, wherein the user scheduled media includes selected stored media arranged according to time,” as recited in claim 10, “selecting the media **stored at the first location** as idle state media or user scheduled media based upon input from a user, wherein the user scheduled media is scheduled based on broadcasting time,” as recited in claim 21, or “wherein all of the idle state media and the user scheduled media is stored in the storage at the first location, wherein all of the idle state media and the user scheduled media are scheduled based on time,” as recited in claim 29.

Accordingly, the Applicants respectfully submit that the Office Action’s reasoning is misplaced, and therefore, a *prima facie* case of unpatentability has not been established. The Office Action has not demonstrated that any of the cited references describes, teaches, or suggests all of the limitations noted above. Thus, for at least these reasons, the Applicants respectfully request reconsideration of the claim rejections.

Additionally, claim 1 recites, in part, “**displaying, from the storage at the first location,** of idle state media when no user scheduled media is available on the television display **at the first location and the at least one display device at the second location.**” Claims 10, 21, and 29 recite similar limitations. Thus, the claims are clear that the idle state media stored at the first location is displayed at first **and** second locations.

The Office Action acknowledges that Ten Kate combined with Wood does not describe, teach or suggest idle state media stored at a first location being displayed at the first location and

the second location. *See* November 19, 2009 Office Action at page 4. In an attempt to overcome this deficiency, the Office Action relies on Hamano. *See id.* at page 5.

Hamano, however, only discloses advertisements displayed on a remote display. *See* Hamano at [0037]. In particular, Hamano discloses a set top box that “transmits the advertising information that has been targeted to the user to the remote display terminal via wireless transmission.” *See id.* at [0044]. Similar to Ten Kate and Wood, however, Hamano does not describe, teach or suggest displaying information stored at a first location on a display at the first location **and** a display at the second location. Instead, similar to the Ten Kate and Wood, Hamano only discloses display at one location. **None of Ten Kate, Wood or Hamano** describes, teaches or suggests “the set top box circuitry at the first location causing the displaying, from the storage at the first location, of idle state media when no user scheduled media is available on the television display at the first location **and the at least one display device at the second location,**” as recited in claim 1. Because none of these references describes, teaches, or suggests this limitation, the combination of all three cannot, by definition, describe, teach, or suggest it.¹ Thus, for at least these reasons, the proposed combination does not render the claims unpatentable.

The Applicants respectfully request reconsideration of the remaining claim rejections for at least the reasons set forth above.

¹ The Applicants are aware that “one cannot show nonobviousness by attacking the references individually,” as the Office Action notes, but if none of the references discloses a limitation, aggregating those references together cannot possibly make the limitation, which is not found in any of the references, somehow appear. For example, if references A, B, and C are silent with respect to element X, then A+B+C cannot somehow yield element X.

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants respectfully request that the outstanding rejections be reconsidered and withdrawn. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney.

The Commissioner is authorized to charge any necessary fees, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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